

REMARKS

Claim status

Claims 1, 3 – 4 stand rejected by the Office Action mailed August 15, 2006.

Affidavit under 37 C.F.R. §1.131

Applicant submits an affidavit under 37 C.F.R. §1.131 to establish an invention date prior to the earliest priority date of Hennessy (U.S. Application No. 11/012,551) which was cited by Examiner. Therefore, Applicant's invention was prior to that of Hennessy.

Section 103(a) rejections

In the August 15, 2006 Office Action, claims 1, 3 – 4 are rejected under 35 U.S.C. §103(a) as being unpatentable over Bathum (US Pat No. 7,055,265) in view of Hennessy (US Application No. 11/012,551). Applicants respectfully traverse the foregoing rejections in view of the above pending claims and for reasons set forth hereafter.

Applicant has submitted an Affidavit under 37 C.F.R. §1.131 (Exhibit B) to establish a date of invention prior to the earliest date of U.S. Application No. 11/12,551. Applicant can establish a date of invention by October 15, 2003, which is before the date of December 12, 2004 in Hennessy. Applicant filed U.S. Trademark Registration No. 3,003,284 (Exhibit A) under 15 U.S.C. §1501(a). Section 1501(a) indicates a current use in commerce as of the trademark application filing date. The trademark application was filed on October 15, 2003. Applicant had reduced the invention to practice as of October 15, 2003 and was marketing the invention with the registered trademark, "IN-SOULS." The trademark registration describes the goods as insouls with Christian messages for mediation and prayer. Therefore, the invention was currently in use as of October 15, 2003, which is before Hennessy's earliest date of invention on December 12, 2004.

When applying 35 U.S.C. §103, the following tenets of patent law must be adhered to:

1. The claimed invention must be considered as a whole;

2. The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
3. The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
4. Reasonable expectation of success is the standard with which obviousness is determined. *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 U.S.P.Q. 182, 187 n.5 (Fed. Cir. 1986). M.P.E.P. §2141 (I).

Applicant's invention discloses a system of providing religious or spiritual inspiration by inserting an insole shaped insert into the wearer's shoe. The invention as a whole is directed towards a shoe insert containing a message and design to be read by the wearer. Considering Bathum as a whole, Bathum does not teach or suggest the claimed inventions of independent claims 1 or 3 and, therefore, independent claims 1 and 3 define allowable subject matter. Bathum does not teach a plurality of insole shaped shoe inserts with a message imprinted on the top portion of the insole. The invention is Bathum is directed toward footwear and more particularly to sandal-style footwear. Col. 1, lines 10 – 15. Bathum teaches a plurality of insoles for use as athletic wear and not for communicating an inspirational message. Col. 6, Lines 8 – 20. The plurality of insoles in Bathum can be used for walking, running, hiking, golfing, or water activities. Col. 5, Lines 5 – 65.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). See M.P.E.P. § 2143 – § 2143.03.

As to the first criteria for a *prima facie* case, there are three possible sources for a motivation to combine references: 1) the nature of the problem to be solved, 2) the teachings of the prior art, and 3) the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references

taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). Bathum solves the problem of wearing sandals while performing athletic activities. Column 1, Lines 36 – 42. The invention in Bathum allows a person to comfortably wear a sandal while running, walking, hiking, golfing, or performing activities in water. Column 1, Lines 18 – 35. On the other hand, Applicant's invention provides a system of communicating and reminding a person of a spiritual message.

As to the second criteria for a *prima facie* case, there is no reasonable expectation of success in combining Bathum with Hennessy. A message imprinted on the insoles in Bathum would wash away when the wearer submerged the insole in water or wear away during athletic activities such as walking, running, hiking, or golfing. Bathum discloses an aquatic-specific insole shown in Figure 14 which includes a porous yet supportive construction to allow the drainage of water through the midsole component and out of the sandal. Column 7, Lines 57 – 62.

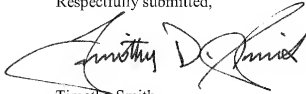
As to the third criteria for a *prima facie* case, Bathum does not teach all the elements of Applicant's invention. Bathum does not disclose, teach or suggest a method of communicating any message. The Examiner has not pointed to any language in Bathum that supports communicating a message on the shoe inserts. Figure 14 does not show a message imprinted on the insole, but shows a system of pores for the drainage of water. Column 7, Lines 57 – 62.

Since claim 4 depends either directly from independent claim 3, it is respectfully submitted that these claims define allowable subject matter as well. Applicant respectfully requests that the rejection of claims 1, 3 – 4 under 35 U.S.C. §103(a) be removed.

Applicant respectfully submits that none of the patents cited in the Notice of References Cited on August 15, 2005 qualifies as prior art for similar reasons as cited above for Bathum. In addition, the references do not disclose all the elements of Applicant's invention. Applicant asserts that the invention is patentable distinct from the references cited, and the references are not pertinent to Applicant's disclosure.

Accordingly, the applicant respectfully requests reconsideration of the rejections. After such reconsideration, it is urged that allowance of all pending claims will be in order.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Timothy D. Smith". The signature is fluid and cursive, with a large, sweeping initial 'T'.

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